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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,082	03/05/2001	Junsaku Nakajima	70551-55675	3271

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EXAMINER

TRAN, THANG V

ART UNIT PAPER NUMBER

2653

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/800,082	Applicant(s) NAKAJIMA ET AL.	
	Examiner Thang V. Tran	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27 is/are allowed.
- 6) ☒ Claim(s) 1, 3-15 is/are rejected.
- 7) ☒ Claim(s) 2 and 16-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The amendment dated 07/07/05 has been considered with the following results:

Claim Objections

1. Claims 1-21 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1:

The statement “whereby said optical beam may be caused to track said pit string”, lines 15-16, does not define any positive limitation because of the term “may be”. Did applicant intend to state that --for controlling said optical beam to track said pit string--?

Claims 2-9 fall with their parent claim 1.

In claim 10:

The term “may be”, line 3, does not define or provide any positive limitation. Applicant is suggested to replace the term “may be” with --is to be--.

Also, the term “will be”, line 7, is suggested to replace with --is to be--.

Claims 11-13 fall with their parent claim 10.

In claims 14 and 15:

The term “will be”, line 2, is suggested to replace with --is to be--.

In claim 16:

The term “will be”, line 16, is suggested to replace with --is--.

Claims 17-21 fall with their parent claim 16.

2. The indicated allowability of claims 5 and 10-15 is withdrawn in view of the newly discovered references. Rejections based on the newly cited references follow.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 3-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-41 of copending Application No. 10/671,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 34-41 of the copending Application No. 10/671,239 respectively include all limitations recited in claims 1 and 3-9 of the present application. The only difference is the wording of the claimed languages.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims in the present application

Claims in the copending Application No. 10/671,239

1	34
3	35
4	36
5	37

6	38
7	39
8	40
9	41

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Morimoto (US 6,226,257).

Regarding claim 10, Morimoto, according to Figs. 16c, discloses an optical disk having a track including a plurality of recessed and protruded portions (see land and groove in Fig. 1 or 5A or see pit and space shown in Fig. 6A) formed thereon in mixed relation to one another; and a ratio of the recessed portions and protruded portion is set such that a tracking error signal (see Fig. 4) has different polarities (see Figs. 5B and 5C or Figs. 6B and 6C) as recited in claim 10 (see column 5, line 24 to column 7, line 27 for further details).

Regarding claims 11 and 12, see Fig. 6A for the limitations recited in these claim.

Regarding claim 13, see Fig. 1 or 5A for the limitations recited in this claim.

Regarding claims 14 and 15, see Fig. 4, 5B, 5C, 6B and 6C for the limitations recited in these claim.

Allowable Subject Matter

7. Claim 2 would be allowable if rewritten to overcome the objection(s) under 37 CFR 1.75(a), set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
8. Claims 16-21 would be allowable if rewritten or amended to overcome the objection(s) to under 37 CFR 1.75(a), set forth in this Office action.
9. Claims 22-27 are allowed.

Response to Arguments

10. Applicant's arguments with respect to claimed invention have been considered but are moot in view of the new ground(s) of rejection.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran
Primary Examiner
Art Unit 2653